



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,095	04/19/2004	Ben Huang	WINN.020C1	1470

20995 7590 06/16/2006

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
----------	--------------

3711

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/827,095	Applicant(s) HUANG, BEN	
	Examiner Stephen L. Blau	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 14-16 is/are allowed.
- 6) ☒ Claim(s) 11-13 is/are rejected.
- 7) ☒ Claim(s) 11-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/2/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination (RCE)

1. The request filed on 2 May 2006 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/827,095 is acceptable and a RCE has been established. An action on the RCE follows.

Information Disclosure Statement

2. The information disclosure statements filed 2 May 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the court papers are not relevant to the processing of this case. During the litigating process of a prior patent, if prior art is discovered that is relevant to a pending case at the patent office the applicant is required to disclose this discovery under 37 CFR 1.97 and 37 CFR 1.98. However it is neither desired nor required to submit to the Patent Office every declaration, objection, answer, order, reply, opposition etc... that is filed in a court litigating a previous patent. In fact in this application there are over 2000 pages of court papers which the applicant is asking the Examiner to review. This is an intense burden on the examiner. Litigating the validity of patents in courts is a completely different process compared to processing a patent application at the U.S. Patent Office. Courts have no set time to decide a case while at the Patent Office the processing of a case is limited

Art Unit: 3711

by time. In this particular art for this case the examiner has only 6 hours to read and understand an invention, review disclosed prior art, perform a search and write a position for a first office action. Clearly reviewing 2000 pages of court papers that were submitted in this case with no logic related to the relevance of this pending application would take a significant portion of this 6 hours if not the entire allotted time or more the examiner has to complete a first office action. And as the litigating process continues the examiner sees no end point to the number of pages of court papers which will be submitted in this case or future cases. If every attorney practicing before the Patent Office did the same as being done in the cases the applicant has before the Patent Office, it would bring the Patent Office to a complete stop in terms of being able to perform its job. Plus the examiner thinks it inappropriate to comment on papers being filed during the litigation of a patent before a court since the approval of patents at the Patent Office and the litigation of the validity of patents in the court are two independent and different processes with different procedures and time frames. It is not the examiner's roll to comment on every court paper which is being submitted before a court. In the past it has been the practice for applicants to use court decisions to argue cases before the Patent Office and not tie up the Patent Office with court papers that will be used to decide cases before a court. As such, due to the nonsensical submission of court papers in this case the examiner will no longer consider court papers on Information Disclosure Statements filed by the applicant.

Claim Objections

3. Claims 11-13 are objected to because of the following informalities: These claims depend on a cancelled claim (Claim 10). Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Sullivan.

Sullivan discloses an underlisting sleeve including a cap and a nipple adapted to retain a strip in the form of abutment (Fig. 3).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell.

Pennell discloses an overlying edges forming a seam (Figs. 2-3) with a small seam width (Fig. 3). Pennell does not disclose the width of a seam but clearly an artisan skilled in forming a grip tape to be placed substantially around a handle of a golf club shaft would have selected a suitable seam width so that the grip material is maximized around a handle in which a seam width of .5 mm is included.

Pennell lacks a seam width of .5 mm. It would have been obvious to modify the grip of Pennell to have a seam width of .5 mm in order to maximize the amount of material around a handle of a shaft to provide comfort and protection to a player from vibrations.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell as applied to claim 11 above, and further in view of Sullivan.

Sullivan discloses an underlisting sleeve including a cap and a nipple adapted to retain a strip in the form of abutment (Fig. 3). In view of the patent of Sullivan it would have been obvious to modify the grip of Penell to have an underlisting sleeve including a cap and a nipple adapted to retain a strip in the form of abutment in order to retain a grip tape on a handle of a shaft more easily.

Allowable Subject Matter

9. Claims 1 and 14-16 are allowed.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/ 10 June 2006


STEPHEN BLAU
PRIMARY EXAMINER